

## **REMARKS**

In this Amendment, Applicants amend claims 1, 4, 7, 13, 14, 18, 19, 20, and 23-25 to more appropriately define the invention. Upon entry of this Amendment, claims 1-26 remain pending and under consideration.

### **Regarding the Office Action:**

In the Office Action, the Examiner rejected claims 1-26 under 35 U.S.C. § 102(e) as being anticipated by *Cochran* (U.S. Patent No. 5,995,979) and also rejected claims 19, 20, and 25 under 35 U.S.C. § 102(e) as being anticipated by *Brunner et al.* (U.S. Patent No. 5,550,971).

### **Regarding the Amendments to claims 19, 20, and 25:**

Applicants amend claims 1, 4, 7, 13, 14, 18, 19, 20, and 23-25 to more appropriately define the invention. Applicants amended claim 1 to recite “information storage accessible through the bus and containing stored information.” Support for Applicants’ amendment to claim 1 can be found, for example, in the specification, on pages 8-11. Claim 4 has been amended to include “said server containing stored items,” and to recite “a list of terms used in the search queries over a period of time to be selectively added to at least one of the stored items.” Support for Applicants’ amendment to claim 4 can be found, for example, in the specification, on page 18, lines 14-26. Claims 7, 13, 14, and 18 have been amended to delete “providing an element for,” and have been amended for clarity. Claims 23 and 24 have also been amended for clarity.

Claims 19 and 25 have been amended to recite “presenting the extracted terms to the user; receiving a user selection of terms; and adding the received terms to a document as a meta-tag.” Support for Applicants’ amendment to claims 19 and 25 can be found, for example, in the

specification, on page 15, line 7- page 16, line 6. Applicants also amended claim 20 to recite “identifying a stored document containing a term; determining if the stored document contains subject matter related to the term; and selectively adding the term to the document as a meta-tag.” Support for Applicants’ changes to claim 20 can be found, for example, in the specification on page 18, lines 14-26.

**Regarding the rejection of claims 1-26 under 35 U.S.C. § 102(e) as anticipated by Cochran:**

Applicants respectfully traverse the rejection of claims 1-26 under 35 U.S.C. § 102(e) as anticipated by *Cochran*. In order to properly establish that *Cochran* anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Regarding the 35 U.S.C. § 102(e) rejection, *Cochran* does not teach each and every element of Applicants’ present invention as claimed.

**I. Independent claims 1 and 4:**

Independent claims 1 recites, *inter alia*:

to process the search queries against the stored information, and to provide a list of terms used in the search queries presented over a period of time to be selectively added to the stored information

Independent claim 4 recites, *inter alia*:

providing search access to the stored items in response to search queries submitted by users, the server configured to provide a list of terms used in the

search queries over a period of time to be selectively added to at least one of the stored items

*Cochran* fails to teach or suggest at least the above-quoted elements of independent claims 1 and 4. The Examiner states on page 4 of the Office Action that “*Cochran* discloses . . . providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form new lists of search terms (See *Cochran* Abstract; Col. 4, lines 1-57; Figure 2 and corresponding text).” However, the cited passages merely describe that “the search request is transmitted to the database . . . and the matching records . . . are stored or marked . . . as a subset of records.” (Col. 8: 45-50). “The subset of records is examined to created updated lists for the list identifiers that were not originally searched. (Col. 8: 54-57). “To generate the correct lists. . . the computer program identifies the search terms contained in each record of the subset of records that has been generated from the first search.” (Col. 8:66-Col. 9:4)

*Cochran* further discloses that “[t]he search terms are placed into an alphabetical, chronological or numerical order and duplicate search terms are eliminated.” (Col. 9:4-7). “The newly generate lists are transmitted back to the user’s computer terminal.” (Col. 9:10-11). This however, is not a teaching or suggestion of at least “to process the search queries against the stored information, and to provide a list of terms used in the search queries presented over a period of time to be selectively added to the stored information,” as recited in independent claim 1, nor is it a teaching of suggestion of at least “providing search access to the stored items in response to search queries submitted by users, the server configured to provide a list of terms used in the search queries over a period of time to be selectively added to at least one of the

stored items,” as recited in independent claim 4. Therefore, *Cochran* fails to disclose at least the above-quoted elements of Applicants’ independent claims 1 and 4, and Applicants submit that independent claims 1 and 4 are allowable, for at least the reasons argued above.

## II. Independent claim 7:

Independent claim 7 recites, *inter alia*:

selecting at least a portion of **relatively high frequency** search terms and processing each search term of the portion for selective addition to documents or files stored in the system **as a meta-tag**

Independent claim 18 recites, *inter alia*:

processing the **highest frequency terms** as candidates for inclusion in documents or files containing the terms **as a meta-tag**

*Cochran* fails to teach or suggest at least the above-quoted elements of independent claims 7 and 18. The Examiner also failed to address these elements in the Office Action. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *see also* MPEP §2131. Therefore, the rejection of claims 7 and 18 is improper and should be withdrawn. Should the Examiner again reject claims 7 and 18, Applicants submit that it should be done in a non-final Office Action in order to afford Applicants to fully respond to the Examiner's reasons.

The Examiner also appears to take the position that allowing entry to be made in the lists in *Cochran* is the same as “**meta-tag**,” as recited in independent claims 7 and 18. (Office Action,

page 7). This position is contrary to well settled rules of claim interpretation that when giving a claim its broadest reasonable interpretation, the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); M.P.E.P. 2111.01. Although limitations from the specification are not to be read into the claim, the proper claim interpretation must be consistent with the specification. *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) ("It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification"). Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999).

Accordingly, the interpretation proposed by the Examiner is unreasonable for at least two reasons. First, the specification states that "meta-information is information about information. Some documents or files contain sections which contain meta-information related to the contents of that document or file. A meta-tag is an entry in a meta-information section of a document or file." (Specification, page 1, lines 8-11). Therefore, in order for a document to have meta-tags, it must have a meta-information section. The *Cochran* lists however, do not contain a meta-information section, and as a result, cannot contain meta tags.

Second, a person skilled in the art of meta-information would readily understand "meta" as "a word denoting a description that is one level of abstraction above the entity being described." *IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, Institute of Electrical and Electronics Engineers, Inc. 2000, page 688. Therefore a meta-tag, as described in

the specification, is an entry in a meta-information section of a document or a file, and it would describe the document or file that it is inserted into. The *Cochran* lists, however, are merely a collection of search terms from many different records, and after the search terms are gathered, they are put into one list. (Col. 8:66-Col. 9:9). Therefore, in order for the entries in this list to meet the definition of meta-tag, they would have to describe the document they are in, and in *Cochran*, the search terms in this new list do not describe the document they are in, but rather “correspond to at least one record in existence in the subset of records.” (Col. 9:5-6). *Cochran* therefore, fails to disclose “meta-tag” as recited in claims 7 and 18.

Therefore, *Cochran* fails to disclose at least the above-quoted elements of Applicants’ independent claims 7 and 18, and Applicants submit that independent claims 7 and 18 allowable, for at least the reasons argued above.

### **III. Independent claims 13 and 23:**

Independent claims 13 and 23 recite, *inter alia*:

adding at least one term selected from the list **based on frequency of occurrence** to at least one document containing the term as a meta-tag

*Cochran* fails to disclose at least the above-quoted elements of Applicants’ independent claims 13 and 23. Again, the Examiner has failed to address this feature of claims 13 and 23 in the Office Action. Applicants submit therefore, that independent claims 13 and 23 are allowable, for at least the reasons argued above.

**IV. Independent claims 14 and 24:**

Independent claims 14 and 24 recite, *inter alia*:

using the **master term list** and the **new term list** as a source of terms for adding to documents containing the terms as a meta-tag

*Cochran* fails to disclose at least the above-quoted elements of Applicants' independent claims 14 and 24. Again, the Examiner has failed to address the above-quoted elements of independent claims 14 and 24 in the Office Action. Applicants submit that independent claims 14 and 24 are allowable, for at least the reasons argued above.

**V. Independent claims 19 and 25:**

Independent claims 19 recites, *inter alia*:

presenting the extracted terms to the user;  
receiving a user selection of terms; and  
adding the received terms to a document as a meta-tag

Independent claim 25 recites, *inter alia*:

for presenting the extracted terms to the user, for receiving a user selection of terms, and for adding the received terms to a document as a meta-tag

*Cochran* fails to disclose at least the above-quoted elements of Applicants' independent claims 19 and 25. While the Examiner notes on page 9 of the Office Action that "[a]s per claims 18-26, most of the limitations of these claims have been noted in the rejection of claims 1-12," the above-quoted features of claims 19 and 25 were not addressed earlier in the Office Action with regard to the rejection of claims 1-12. Applicants submit that independent claims 19 and 25 are allowable, for at least the reasons argued above.

**VI. Independent claims 20, 21, and 26:**

Independent claim 20 recites, *inter alia*:

determining if the stored document contains subject matter related to the term; and  
selectively adding the term to the document as a meta-tag

Independent claims 21 and 26 recite, *inter alia*:

identifying documents or files containing at least one of said terms; and  
selectively adding said at least one of said terms to said document or file  
as a meta-tag

*Cochran* fails to disclose at least the above-quoted elements of Applicants' independent claims 20, 21, and 26. As discussed with regard to independent claims 1 and 4, "[t]he subset of records [in *Cochran*] is examined to create updated lists for the list identifiers that were not originally searched." (Col. 8: 54-57). "To generate the correct lists. . . the computer program identifies the search terms contained in each record of the subset of records that has been generated from the first search. The search terms are placed into an alphabetical, chronological or numerical order and duplicate search terms are eliminated." (Col. 8:66-Col. 9:4). "The newly generated lists are transmitted back to the user's computer terminal." (Col. 9:10-11). This disclosure of *Cochran*, however, does not constitute a teaching or suggestion of at least "determining if the stored document contains subject matter related to the term; and selectively adding the term to the document as a meta-tag" as recited in independent claim 20, nor a teaching of at least "identifying documents or files containing at least one of said terms; and selectively adding said at least one of said terms to said document or file as a meta-tag," as recited in independent claims 21 and 26. Applicants submit that independent claims 20, 21, and 26 are allowable, for at least the reasons argued above.



In addition, Applicants submit that claims 2-3, 5-6, 8-12, 15-17, and 22 are also allowable at least by virtue of their dependence from allowable base claims 1, 4, 7, 13, 14, and 18-21. Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(e) rejection.

**Regarding the rejection of claims 19, 20, and 25 under 35 U.S.C. §102(e) as anticipated by *Brunner et al.*:**

Independent claims 19 recites, *inter alia*, “presenting the extracted terms to the user; receiving a user selection of terms; and adding the received terms to a document as a meta-tag.” Independent claim 25 recites, *inter alia*, “for presenting the extracted terms to the user, for receiving a user selection of terms, and for adding the received terms to a document as a meta-tag.” Independent claim 20 recites, *inter alia*, “determining if the stored document contains subject matter related to the term; and selectively adding the term to the document as a meta-tag.” The Examiner states on page 10 of the Office Action that the claimed features of claims 19-20 and 25 are in the Abstract, and column 2, lines 45 to column 3, line 22 of *Brunner et al.* However, a careful review of the cited passages reveal that *Brunner et al.* does not disclose the above-quoted features of independent claims 19 and 25.

At most, *Brunner et al.* will display to the user the search queries of the initial search and a narrowed search, (col. 4:54-60), and “to search the . . . database, a user types query constrains in the areas [of the user interface] to locate specific instances” (col. 15:59-61). Such disclosure fails to constitute “presenting the extracted terms to the user; receiving a user selection of terms; and adding the received terms to a document as a meta-tag,” as recited in independent claims 19, or “for presenting the extracted terms to the user, for receiving a user selection of terms, and for adding the received terms to a document as a meta-tag,” as recited in independent claim 25.